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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/908,453	08/07/1997	GARY RUVKUN	08472/704002	9530

7590

06/11/2003

CLARK & ELBING
176 FEDERAL STREET
BOSTON, MA 02110

EXAMINER

SHUKLA, RAM R

ART UNIT	PAPER NUMBER
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1632

39

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/908,453

Applicant(s)

RUVKUN ET AL.

Examiner

Ram R. Shukla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-8, 10-16 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 14 and 21-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 10-13, 15, 16, 18-20, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 33.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The appeal brief filed 3-4-03 has been received and entered. However, in view of the new art rejection, the finality of the final action of 3-26-02 is herewith withdrawn and a new office action is set forth below.
2. During a telephonic conversation on 6-4-03, Karen Elbing, applicants' representative agreed to amend claim 15 to replace the term "a nematode cell" with "a C.elegans cell" in step a and amending other steps of the claim to correct "antecedent basis" for the term. In view of applicants' agreeing to amend claim 15, the enablement rejection of claims 15, 19 and 20 (claims subject to appeal in view of the final office action of 3-26-02) has been withdrawn.
3. During a telephonic conversation on 6-5-03, Karen Elbing, applicants' representative was informed of the availability of SWINBURNE J et al. EMBL Database accession no. Z66519 (C. elegans cosmid B0334) a reference supplied in a recent EPO search report as a potential art. Ms. Elbing's associate Ms. Mallisa Hunter, on 6-6-03, requested a new office action since inventors could not be contacted.
4. Claims 1-7, 14, and 21-28 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 15.
5. This application contains claims 1-7, 14, and 21-28 drawn to an invention nonelected with traverse in Paper No. 15. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
6. Claims 8, 10-13, 15, 16, and 19-20 are instantly under consideration in the instant application.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 8, 10 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by Swinburne J. (EMBL Accession No. Z66519, 27 October 1995).

Swinburne J teaches the nucleotide sequence of the C.elegans cosmid B0334 and discloses the amino acid sequence, which encompasses the amino acid sequence of SEQ ID NO 1. It is noted that the DNA encoding the amino acid sequence of SEQ ID NO 1 was isolated from this cosmid. The vector and host cell comprising the DNA are anticipated because both these are part of cloning and sequencing a DNA molecule.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8, 10-13, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swinburne J. (EMBL Accession No. Z66519, 27 October 1995) in view of Johnson et al (Genetica 91:65-77, 1993).

Swinburne J teaches the nucleotide sequence of the C.elegans cosmid B0334 and discloses the amino acid sequence, which encompasses the amino acid sequence of SEQ ID NO 1. Swinburne does not teach a method of making a protein from SEQ ID NO 1 or a method of screening for compounds that decrease AGE-1 gene.

Johnson et al teach C.elegans mutants, selective breeding, method of cloning genes and the significance of cloning the gene responsible for aging, age-1 and screening

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of animals for effect of different plasmids comprising DNA (see the entire document, for example, table 2, figure 4 etc.)

At the time of the invention, it would have been obvious for an artisan of skill to express the DNA of Swinburne in a cell and express the protein in a cell, isolate the protein and study its function or practice method of identifying compounds that decrease the expression of Age-1 by following the method of Johnson et al and routine cell culture methods. An artisan of skill would have been motivated to express Age-1 in a cell, isolated Age-1 protein and tested its activity because Swinburne identified putative functional domain. Additionally, an artisan would have been motivated to practice the screening methods for identifying compounds that decrease Age-1 activity because Johnson et al teaches that molecular cloning and characterization of Age-1 locus will provide significant insights into the molecular basis of senescence.


11. No claim is allowed.

1. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 8-13-02 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for this Group is (703) 308-4242. The after-final fax number is (703) 87209307. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (703) 305-3413.


RAM SHUKLA
PRIMARY EXAMINER

Ram R. Shukla, Ph.D.
Primary Examiner
Art Unit 1632